

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: Jennifer Reed

Confirmation No.: 5467

Application No.: 10/823,810

Group Art Unit: 1646

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Examiner: Chandra, Gyan

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For: METHODS OF PREVENTING OR
TREATING RESPIRATORY CONDITIONS

Attorney Docket No.: IL500US

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Commissioner for Patents
P.O. Box 1450
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APPLICATION FOR PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)

Applicant hereby requests reconsideration of the 628-day patent term adjustment (PTA) of U.S. Patent 7,582,297. Applicant's request is timely filed because (i) it is less than two months from issuance of the aforementioned patent and (ii) the Office could not process this request prior to issuance of the patent, *i.e.*, to fully process this request the Office must know the issue date of the patent.

Please charge the fee set forth in 37 C.F.R. § 1.18 (e) and any other fee deemed necessary for consideration of this request to Deposit Account No. 500479.

Statement of Facts

1. Correct term adjustment and the bases for the correct term adjustment.

- (i) Applicant respectfully submits that the correct PTA under 35 U.S.C. § 154 (b) is 1057 days.
- (ii) The bases for the reconsideration of the PTA are:
 - (a) the USPTO did not correctly calculate the number of days it failed to issue a patent beyond three years of the actual filing date of the application in the United States as required under 35 U.S.C. § 154 (b) (1) (B); and
 - (b) the USPTO did not properly add the number delay days it failed to issue a patent beyond three years of the actual filing date of the application in the United States as required under 35 U.S.C. § 154 (b) (1) (B) to any patent term adjustment which Applicant accrued as a result of delays in responses from the Office under 35 U.S.C. § 154 (b) (1) (A). See *Wyeth v. Dudas*, 580 F. Supp. 2d 138 (D.D.C. 2008) (holding that delay periods occurring under 35 U.S.C. § 154 (b) (1) (B) and 35 U.S.C. § 154 (b) (1) (A) "overlap" when they occur on the *same calendar day*).

2. Relevant dates for which patent term adjustment is sought under 37 C.F.R. § 1.703

- (i) 37 C.F.R. § 1.703 (a): As PAIR indicates, the period of adjustment of patent term due to examination delay under 37 C.F.R. § 1.703 (a), *i.e.*, 35 U.S.C. § 154 (b) (1) (A), is 536 days:
 - (a) 467 days of delay, delay in mailing an action under 35 U.S.C. § 132 fourteen months following the filing an application under 35 U.S.C. § 111 (a). See 37 C.F.R. § 1.703 (a) (1) (delay from June 12, 2005 - September 22, 2006); and
 - (b) 69 days of delay, delay in issuing a patent more than four months after the date the issue fee was paid and all outstanding requirements were satisfied (37 C.F.R. § 1.703 (a) (6)) (delay from June 24, 2009 - September 1, 2009).
- (ii) 37 C.F.R. § 1.703 (b): Contrary to the PTO's calculation, the period of adjustment of patent term due delay in issuing a patent three years after Applicant's filing the application under 37 C.F.R. § 1.703 (b), *i.e.*, 35 U.S.C. § 154 (b) (1) (B), should be 835 days. Applicant's filing date is April 12, 2004. The application issued as a patent September 1, 2009. The delay in issuing the patent is calculated from the day after the

date that is three years after the date on which the application was filed (April 13, 2007) to the date the patent was issued (September 1, 2009). See 37 C.F.R. § 1.703 (b). This delay is 872 days. According to 37 C.F.R. § 1.703 (b) (4), this number is to be reduced by the number of days beginning on the date on which a notice of appeal to the BPAI was filed (October 15, 2008) and ending on the date of mailing a notice of allowance (November 24, 2008), if the appeal did not result in a decision by the BPAI. Thus, the 872 days is reduced by the 37 days between October 15, 2008 and November 24, 2008. Reduction of the 872 days by 37 days is 835 days of delay under 37 C.F.R. § 1.703 (b).

- (iii) 37 C.F.R. §§ 1.703 (c) – (e): As PAIR indicates, there are no period of adjustment of patent term due to examination delay under 37 C.F.R. §§ 1.703 (c) – (e).
- (iv) 37 C.F.R. § 1.703 (f): Contrary to the Patent Office’s calculation, the PTO delayed issuance of Applicant’s patent a total 1302 days under 37 C.F.R. § 1.703 (f). 37 C.F.R. § 1.703 (f) states that the “term of a patent entitled to adjustment under § 1.702 and this section shall be adjusted for the sum of the periods calculated under paragraphs (a) through (e) of this section [37 C.F.R. § 1.703], to the extent that such periods are *not overlapping*...” (emphasis added). The *Wyeth* court held that delays under 37 C.F.R. §§ 1.703 (a) and (b), respectively, are *not overlapping* if they occur on different calendar days. Application of the *Wyeth* court’s holding provides that the Office should add the 467 day delay under 37 CFR § 1.703 (a) (1) to the 835 day delay under 37 C.F.R. § 1.703 (b) for a total of 1302 days. See below:
 - (a) 37 CFR § 1.703 (a) (1) delay of 467 days over June 12, 2005 - September 22, 2006 does not overlap any calendar days with the 37 C.F.R. § 1.703 (b) delay over April 13, 2007 - September 1, 2009. Thus, the 467 day delay under 37 CFR § 1.703 (a) (1) and the 835 day delay 37 C.F.R. § 1.703 (b) are added = 1302 days.
 - (b) 37 C.F.R. § 1.703 (a) (6) delay of 69 days over June 24, 2009 - September 1, 2009 overlaps all its calendar days with the 835 day delay under 37 C.F.R. § 1.703 (b) over April 13, 2007 - September 1, 2009. Thus, the 37 CFR § 1.703 (a) (6) delay is not added to the 37 C.F.R. § 1.703 (b) delay.
 - (c) The total period of PTO delay is thus addition of the 467 day delay under 37 CFR § 1.703 (a) (1) and the 835 day delay 37 C.F.R. § 1.703 (b) = 1302 days.

3. The patent is not subject to a terminal disclaimer

4. Reduction of period of adjustment of patent term under 37 CFR § 1.703 (d)

As PAIR indicates, the reduction in period of adjustment of patent term under 37 C.F.R. § 1.704 is 245 days.

In consideration of the facts described above, Applicant respectfully submits that the PTA equals

1302	days due to USPTO delay (see 2, above)
- 245	days due to Applicant delay (see 4, above)
<u>1057</u>	days.

Respectfully submitted,

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